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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,361	04/20/2000	Aviel D. Rubin	1999-0728	4969

7590
Mr S H Dworetsky
AT & T Corp
PO Box 4110
Middletown, NJ 07748

EXAMINER

OPSASNICK, MICHAEL N

ART UNIT	PAPER NUMBER
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2626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/553,361

Applicant(s)

RUBIN ET AL.

Examiner

Michael N. Opsasnick

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/15/04 (petition received).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 17, 20, 21, 23-27 and 32-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 17, 20, 21, 23-27 and 32-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No: _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-13,35,38-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per independent claim 1, the claim recitations pertaining to a module that “operates without having received a list of said keywords pre-specified by said individual” is vague and indefinite. It is not clear as to what the module can operate with, i.e., can the module operate without any list, can the module operate with a list not pre-specified, or can the module operate with a pre-specified list, but not by the said individual. Although negative limitations are now acceptable, these types of limitations must still set the boundaries of the invention. See MPEP 2173.05(i) *(Negative Limitations The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph. Some older cases were critical of negative limitations because they tended to define the invention in terms of what it was not, rather than pointing out the invention. Thus, the court observed that the limitation “R is an alkenyl radical other than 2-butenyl and 2,4-pentadienyl” was a negative limitation that rendered the claim indefinite because it was an attempt to*

Art Unit: 2626

claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. In re Schechter, 205 F.2d 185, 98 USPQ 144 (CCPA 1953).)

Dependent claims 2-13,35,38-40 are also rejected under 35 U.S.C. 112 2nd paragraph because these claims depend from claim 1 which has been determined to be vague and indefinite under 35 U.S.C. 112 2nd paragraph.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-14,17,20,21,23-27,32-34,41,42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beck et al (6167395) in view of Flores et al (5216603).

As per claims 1,14,17,20,41,42 Beck et al (6167395) teaches a method for retaining broadband communications comprising the steps adding at least a portion of a communication session in which said individual is a participant to a stored corpus of communication session (col. 6 lines 24-50; examiner notes that the preamble is not afforded patentable weight since it consists of descriptive language that is not reinforced in the body of the claim -- A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for

Art Unit: 2626

completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).) and selecting keywords related to said communication session for subsequently searching to find said communication session (abstract). Beck et al(6167395) also teaches keyword summarization (col. 9 lines 38-51), content based access of the communicated information (col. 10 lines 10-50), however, Beck et al(6167395) does not explicitly teach creating a database wherein the database contains selected keywords of a communication session so that it can be subsequently searched via the chosen keywords, however, Flores et al (5216603) teaches keyword association with present and past conversations to be used (Fig. 15,16; fig 13-14, fig. 17, col. 42 lines 31-45; col. 54 lines 12-26). Therefore, it would have been obvious to one of ordinary skill in the art of conversation recordkeeping systems to modify the teachings as taught by Beck et al (6167395) with conversation keyword association because it would advantageously allow for easier access to already stored conversations (Flores et al, fig. 15; fig. 18; col. 4 lines 20-35).

As per claims 2,21, and 23, Beck et al (6167395) teaches:

“converting.....text information” as converting speech to text (Fig. 7, subblocks 185)

As per claims 3, 24, Beck et al (6167395) teaches:

“step of identifying.....session” as automated detection and updating the database during user operations (col. 18 lines 10-24; and col. 20 lines 47-59;figs. 6,7, and 9)

Art Unit: 2626

As per claim 4, Beck et al (6167395) teaches:

“prompting said individual.....keywords” as analyzing association criteria and making a selection based on that criteria (abstract)

As per claims 5,25, and 26, Beck et al (6167395) teaches:

“outgoing packets....first party to said individual” as packets of information transferred from the first party to the second party (Figs. 2,4, and 6)

As per claims 6, 27, Beck et al (6167395) teaches:

“determining whether explicit approval.....second party” as logging into a network via password protection (Fig. 6; col. 24 lines 14-40)

As per claims 7,9,10, Beck et al (6167395) teaches storing meta information and packets to memory (Fig. 7, subblock 191)

As per claims 8,35-39, Beck et al (6167395) teaches constraining access of the user to certain information with additional permission – examiner notes that the user access is based upon enrollment/security recognition, and after access, the access to certain features of the software is based upon user –specific codes - a two step security/encrypted process(col. 25 line 60 – col. 26 line 17)

As per claims 11,32, Beck et al (6167395) teaches voice/speech recognition to convert to text using keywords (col. 21 lines 35-47)

As per claims 12, 33, 34, Beck et al (6167395) teaches searching the database (fig. 7)

As per claims 13,33, and 34, Beck et al (6167395) teaches storing and retrieving information from the database for parsing or review (col. 24 lines 37-65).

Response to Arguments

5. Applicant's arguments received 7/15/2004 via petition have been fully considered but they are moot in view of the new grounds of rejection. Examiner notes the 112 rejections to address the new claim limitations, and the newly cited portions of Beck to address the other new claim limitations.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please note the Mikurak (6606744) reference teaching third party secure access to packet information.

Art Unit: 2626

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Opsasnick, telephone number (571)272-7623, who is available Tuesday-Thursday, 9am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Richemond Dorvil, can be reached at (571)272-7602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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